access the data as a first data element in a first register when the system operates with a first type of software, and as a second data element in a second register when the system operates with a second type of software.

Hence, claim 1 requires accessing the same data held in the storage element as a first data element in a first register when the system operates with a first type of software, and accessing the data as a second data element in a second register when the system operates with a second type of software.

The Examiner holds Nguen to differ from the claimed invention in that the reference does not disclose the claimed alternate access circuitry. Poisner is relied upon for disclosing this circuitry.

Considering the references, Nguen discloses dual booting capabilities for installing two operating systems in a computer system. However, the reference does not teach or suggest accessing the same data as different data elements stored in different registers depending on the type of software.

Poisner does not disclose using different types of software. Accordingly, this reference cannot suggest accessing the same data as different data elements stored in different registers depending on the type of software.

Hence, the combined teachings of the references are not sufficient to suggest accessing the same data held in the storage element as a first data element in a first register when the system operates with a first type of software, and accessing the data as a second data element in a second register when the system operates with a second type of software, as claim 1 requires.

It is well settled that the test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art. ***Cable Electric Products, Inc. v. Genmark, Inc.***, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985). In determining whether a case of *prima facie* obviousness exists, it is necessary to ascertain whether the prior art teachings appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification. ***In re Lalu***, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

As shown above, the reference combination applied by the Examiner is not sufficient to arrive at the invention recited in claim 1. Claims 2-13 dependent from claim 1 are defined over the prior art at least for the reasons presented above in connection with claim 1.

*REJECTION OF CLAIMS 15-20*

Independent claim 15 recites a network interface comprising:

- a host interface for supplying address, data and control signals from a host,

- storage element for holding a data element accessible via the host interface, and

- alternate access circuitry coupled to the storage element for providing multiple paths for accessing the data element, and configured to select a path for accessing the data element depending on a type of software used to operate the network interface.

Independent claim 18 recites a method of providing access to a storage element for holding a data element, comprising the steps of:

- accessing the storage element via a first access path when a first type of software is used to operate the data processing system, and

- accessing the storage element via a second access path when a second type of software is used to operate the data processing system.

Hence, claims 15 and 18 require accessing the same data element or storage element via different access paths depending on a type of software.

It is respectfully submitted that neither Nguyen et al. nor Poisner teaches or suggests accessing the same data element or storage element via different access paths depending on a type of software.

Accordingly, the combined teachings of these references are not sufficient to suggest the invention recited in claims 15 and 18. Claims 16-17, and 19-20 respectively dependent from claims 15 and 18 are defined over the prior art at least for the reasons presented above in connection with the claims 15 and 18.

Accordingly, the Examiner's rejection of claims 1-13 and 15-20 is improper and should be withdrawn.

In view of the foregoing, and in summary, claims 1-13 and 15-20 are considered to be in condition for allowance. Favorable reconsideration of this application is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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